

### **REMARKS**

Claims 4, 10, 11, 16, 19, 24-40, 43, 44, 46, 48-50, 53 and 55-57 are canceled.

Independent Claim 1, and its dependant Claims 3, 5, 12, 13, 15, 45, 47, 51 and 52 are amended.

Independent Claim 18, and its dependant Claims 17, 20-23 and 42 are also amended.

Claims 9, 54, 41, 58 and 14 are withdrawn as being directed to a non-elected invention.

Accordingly, Claims 1, 3, 5, 6-8, 12, 13, 15, 45, 47, 51, 52, 18, 17, 20-23 and 42 remain pending for consideration.

#### **The Restriction Requirements**

Applicants elect, with traverse, Group I and Species a) and d), Claims 1-3, 5-8, 12-13, 15-18, 20-24, 42, 45-53 and 55-57 for examination on the merits.

Applicants traverse this restriction because the Office has not set forth reasons for why there would be burden on the Examiner if the restriction is not made. The restriction, therefore, was improperly made. *See e.g.*, MPEP §§ 803, 808.

The Examiner did not provide a reason for why there would be a burden when the Examiner called Applicants' representative, nor is there a reason given in the Official Action. Rather, the Official Action appears to simply recite sections of MPEP § 806. For instance, at paragraph 2 the Official Action concludes that Group I and II are directed to related processes, recites the situations for distinctiveness as set forth in MPEP § 806.05(j), and then concludes that "the inventions as claimed are distinct processes".

MPEP § 808.02 states that "[w]here the inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, *must* explain why there would be a serious burden on the examiner if restriction is not required" (emphasis added). Merely reciting sections of the MPEP, without any explanation for why the rule applies to Applicants' claims, does not satisfy the initial burden that the Examiner explain why there would be a

serious burden. Since the Examiner has not satisfied the Office's initial burden of explaining why there would be a burden if restriction was not required, the restriction requirement is traversed as being improperly made.

**Claim Rejections under 35 U.S.C. § 112**

The undersigned wishes to thank Examiner Cameron for her careful and thorough review of Applicants' claims.

The Rejections under the first paragraph of Section 112

Claims 1, 12, 18, 21, 23, 46, 47, 52, 53, 55, 56 stand rejected under the first paragraph of Section 112. Claims 1, 12, 18, 21, 23 and 47 are amended. Claims 46, 52, 53, 55 and 56 are canceled. Moreover, support for the amended claims are provided in the following areas of the specification (reference is made to the publication of the application, US2005/00774544):

Support for Claim 1 may be found at FIG. 11 and paragraphs [0017] and [0052]. The language quoted at 10.b), page 9, is removed.

Support for Claim 12 may be found at paragraph [0047].

Support for Claim 18 may be found at FIG. 10 and paragraphs [0019] and [0049]. It is believed that Claim 18 as amended addresses the concerns raised at 10.f)-g), pgs. 9-10.

Support for Claim 21 may be found at paragraph [0047]. The word "member" is no longer present in this claim.

Support for Claim 23 may be found at paragraph [0047]. The word "member" is no longer present in this claim.

Support for Claim 47 may be found at [0049].

In view of the foregoing, Applicants respectfully ask that all standing rejections under 35 U.S.C. § 112, first paragraph be withdrawn.

The Rejections under the second paragraph of Section 112

Claims 1-3, 5-8, 12-13, 15-18, 20-24, 42, 45-53 and 55-57 stand rejected under the second paragraph of Section 112. Claims 1-3, 5, 12, 13, 15, 17, 18, 20, 21, 23, 42, 45, 47, 51, and 52 are amended and Claims 48-50, 24, 46, 53, 55-57 are canceled. It is believed that with entry of the foregoing claim amendments, all matters concerning Section 112, second paragraph should now be resolved.

In view of the foregoing, Applicants respectfully ask that all standing rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

After review of the claims and specification, it is believed that all of the Examiner's concerns regarding compliance with § 112, ¶¶ 1, 2 should now be resolved. Should the Examiner still have concerns over whether the claims satisfy the requirements of § 112 after entry of the amendments and review of the specification, the Examiner is invited to contact the undersigned at the number provided below so that any remaining matters can be quickly resolved.

**Claim Rejections 35 U.S.C. §§ 102, 103**

Claims 1, 5, 7-8, 13, 15-18, 20, 22-24, 47 and 49-51 stand rejected under 35 U.S.C. § 102(e) as anticipated by *Shekalim* (US6971813).

*Shekalim* illustrates various embodiments of a contacting coating apparatus for a prosthesis. FIG. 1 depicts a combination of a roller (10), stent (14) and a wiper (18). The stent and roller rotate in opposite directions. FIG. 3 depicts an arrangement in which a prosthesis 14 is placed on opposed rollers 10. FIGS. 2 and 6 depict arrangements in which a tampon (20) is rotated and displaced so as to transfer a coating substance from a sponge cartridge (60) or reservoir (12) onto a rotating prosthesis (14). In FIG. 7 a tray (70) is said to move laterally so that different compositions are applied to the prosthesis (14).

Independent Claims 1 and 18

Claim 1 describes a method of coating a tubular implantable medical device, including the steps of depositing a coating composition on an applicator, rotating the applicator over the length of the device to apply a first stripe of coating composition to a surface of the device, rotating the device about its longitudinal axis, and then applying a second stripe of coating composition to the surface of the device.

One example of the method set forth in Claim 1 is discussed at paragraph [0052] and FIG. 11 of Applicants' specification.

*Shekalim* does not anticipate Claim 1. The reference does not teach or suggest either the rotating the applicator over the length of the device to apply a first stripe of coating composition to a surface of the device step, nor the rotating the device and then applying a second stripe step as set forth in Claim 1.

Anticipation under 35 U.S.C. § 102 requires that each limitation of a claim is found in a single reference either expressly or inherently. *See Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 77 USPQ2D 1321 (Fed. Cir. 2005). As explained above, *Shekalim* does not teach or suggest every feature of Claim 1. *Shekalim* therefore cannot anticipate Claim 1. For this reason Applicants' respectfully ask that the rejection of Claim 1 under 35 U.S.C. § 102(b) be withdrawn.

Allowance of Claim 1 is earnestly solicited.

Claim 18 describes a method of coating a tubular implantable medical device, including the steps of rotating an application roller in a first direction, providing a controlled deposition of a coating composition onto a surface of the rotating application roller by depositing a mass of coating composition onto a rotating metering roller disposed in close proximity to, or in contact with the surface of the application roller, and transferring the coating composition from the application roller to the device including the steps of disposing the device in close proximity to, or in contact with the surface of the application roller holding the deposited coating composition, and rotating the device in a second direction, opposite to the first direction so as to cause the coating composition to be transferred from the application

roller to the device as the application roller and device rotate in the first and second directions, respectively.

One example of the method set forth in Claim 18 is discussed at paragraph [0049] and FIG. 10 of Applicants' specification.

*Shekalim* does not anticipate Claim 18. The reference does not teach or suggest the step of providing a controlled deposition of a coating composition onto a surface of a rotating application roller by depositing a mass of coating composition onto a rotating metering roller disposed in close proximity to, or in contact with the surface of the application roller, in combination with the other steps of Claim 18. Since the reference does not teach or suggest every feature of Claim 18, it cannot anticipate the claim. For this reason Applicants' respectfully ask that the rejection of Claim 18 under 35 U.S.C. § 102(b) also be withdrawn.

Allowance of Claim 18 is earnestly solicited.

Dependent Claims 5-8, 12, 13, 15, 17, 20-23, 45, 47, 51 and 52

Claims 5-8, 12, 13, 15, 17, 20-23, 45, 47, 51 and 52 depend from Claims 1 and 18 and recite(s) additional features that further distinguish Applicants' invention over the art of record. However, it is not necessary to point out the additional features recited in these dependant claims. Because Claims 5-8, 12, 13, 15, 17, 20-23, 45, 47, 51 and 52 depend from allowable claims, they are also allowable. For this reason, Applicants ask that all standing rejections of Claims 5-8, 12, 13, 15, 17, 20-23, 45, 47, 51 and 52 under 35 U.S.C. §§ 102 and 103, respectively, be withdrawn.

In view of the foregoing claims and accompanying remarks Applicants respectfully ask that all pending claims be indicated as allowable.

**CONCLUSION**

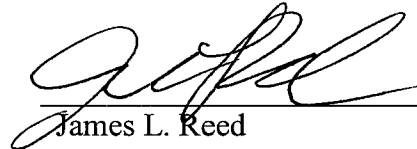
In light of the foregoing claim amendments and remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Date:

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